

REMARKS

This is in response to the Office Action dated December 10, 2007. Claims 1-29 are pending in the present application, of which claims 6-29 stand withdrawn from consideration. A spelling error is corrected in the specification. No new matter is added by this Amendment. Reconsideration of process claims 1-5 is earnestly solicited, based upon the arguments set forth below.

Prior art rejection

Claims 1-5 were rejected as being unpatentable over Yur've et al. in view of Takai '618, DE '465, JP '006, Hau, and JP '043. Office Action, pages 5-6. The rejection is respectfully traversed. A crucial feature of this ground of rejection is the Examiner's assertion that it is "obvious to prepare the bicyclohexyl diepoxide of Yur've et al. using an ethyl acetate solution of peracetic acid as per Takai ... having little or no water as shown in Takai ... in order to ... prevent the hydrolysis of the epoxy groups (Takai, page 4, paragraph 47)".¹ The Takai published application has a publication date of March 27, 2003, which is less than a year prior to Applicants' international filing date of September 4, 2003. All of claims 1-5 herein are supported in Applicants' priority application JP 2002-260490, which was filed on September 5, 2002. Provided herewith is an accurate English-language translation of a certified copy of JP 2002-260490, which perfects Applicants' claim to the September 5, 2002 priority date. Therefore, the Takai publication is a reference only as of its March 20, 2002 U.S. filing date. However, the invention of application Serial No. 10/526,672 (i.e., the present application) and the invention described in application Serial No. 10/103,645 (i.e., the Takai application) were both owned by Daicel at the time the present invention was made. Accordingly, the Takai published application cannot be used in an obviousness rejection against claims 1-5 in the present application. Without the teachings of the Takai reference upon which the Examiner

¹ It is noted that the Examiner refers to the primary reference in this rejection as "Yur've". The article was cited by Applicants, however, as "Yu've".

relies, the rejection of claims 1-5 as being unpatentable over Yur've et al. in view of Takai '618, DE '465, JP '006, Hau, and JP '043 fails, and must be withdrawn.

Provisional double patenting rejections

On pages 2-4 of the Office Action, claims 1-5 are rejected on the ground of obviousness-type double patenting over claim 4 of copending application Serial No. 10/567,253 in view of Yur've, Takai '618, DE '465, JP '006, Hau, and JP '043. The rejection is respectfully traversed. Claim 4 of application Serial No. 10/567,253 is drawn to a thermosetting resin composition, while the present claims are drawn to a process for the preparation of an alicyclic diepoxy compound. Therefore the double patenting rejection is untenable. Moreover, none of the ancillary references in this rejection discloses epoxidation with organic percarboxylic acids (as required by claims 1-5 herein) except for Takai '618, and Takai '618 has been removed as a reference in obviousness rejections² against this application. In any case, the rejection is provisional, which means that consideration thereof may be postponed until one of the involved applications is allowed.

On pages 4-5 of the Office Action, claims 1-5 are rejected on the ground of obviousness-type double patenting over claims 5 and 6 of copending application Serial No. 10/883,162 in view of Yur've, Takai '618, DE '465, JP '006, Hau, and JP '043. Claims 5 and 6 of application Serial No. 10/883,162 are drawn to a liquid epoxy resin composition, while the present claims are drawn to a process for the preparation of an alicyclic diepoxy compound. Therefore the rejection is not justified. Moreover, as indicated above, none of the ancillary references discloses epoxidation with organic percarboxylic acids as required by claims 1-5 herein except for Takai '618, and Takai '618 has been removed as a reference in obviousness-type rejections

² MPEP 804 states that "the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection" on page 800-21 of Rev. 5, Aug. 2006.

against this application. In any case, the instant double patenting rejection is provisional, so consideration thereof may be postponed until one of the applications involved is allowed.

Contact information

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher, Registration No. 28,781, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: MAR 10 2008

Respectfully submitted,

By 
R6—Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant